

### REMARKS

This responds to the Office Action dated March 31, 2006.

Claims 16, 18, and 21 are amended and claims 23-25 are cancelled. Claims 16-22 are pending in this application.

### Objection to the Claims

Claim 18 was objected to as lacking antecedent basis in claim 16. Claim 21 was objected to under 37 C.F.R. 1.75(c) as being on improper dependent form for failing to further limit the subject matter of the previous claim. Applicant has amended claims 18 and 21 to overcome the objections.

### §102 Rejection of the Claims

Claims 16, 17 and 19-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sherman (U.S. Patent No. 6,059,778).

### Claims 16-22

Applicant has amended claim 16 to better describe the subject matter recited in the claim. Applicant believes that claim 16 is not anticipated by the cited reference since the reference does not include each limitation recited in the claim. For instance, Applicant cannot find in the cited reference: a catheter having one or more electrodes proximate a distal end of the catheter, the catheter configured for being positioned such that the one or more electrodes are adjacent the endocardial tissue, at least one of the electrodes including a tip electrode having a thermal time constant of approximately 240 ms; and a power control system configured to provide power to the tip electrode, the power having a plurality of alternating on portions and off portions, one set of adjacent on and off portions defining a duty cycle; wherein the power control system delivers an energy pulse of between approximately 0.01 ms to 4 ms via the tip electrode, and the on portions and off portions of the duty cycle have a ratio of between 50% - 100%, as recited in claim 16. In contrast, the cited reference discusses controlling the duty cycle of energy delivered

via ring electrodes 32. There is no discussion of any details of tip electrode 36. The Office Action asserts that such subject matter is inherent in the cited reference. However, the cited reference includes no discussion of such a capability.

Applicant believes the Office Action has not established a *prima facie* case of inherency because, as recited in MPEP § 2112, “In relying upon the theory of inherency, the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,” citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Here, the Office Action only argued that Sherman is “inherently capable of this intended use.” (Page 3 of Office Action). Thus, the Office Action does not even assert that the allegedly inherent characteristic is necessary, let alone provide a basis in fact and/or technical reasoning.

Claims 17 and 19-22 include each limitation of their parent claim and are therefore also not anticipated by the cited reference. Reconsideration and allowance is respectfully requested.

#### §103 Rejection of the Claims

Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sherman (U.S. Patent No. 6,059,778). Claim 18 includes each limitation of its parent claim and is not obvious over the cited reference for the reasons given above. Reconsideration and allowance are respectfully requested.

Claims 23-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sherman (U.S. Patent No. 6,059,778) in view of Sherman (U.S. Patent No. 5,971,980). Claims 23-25 are cancelled without prejudice or disclaimer.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

Serial Number: 10/698,026

Filing Date: October 30, 2003

Title: ENERGY DELIVERY OPTIMIZATION FOR RF DUTY CYCLE FOR LESION CREATION

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Dkt: 279.401US1

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1460, Alexandria, VA 22313-1450, on this 30 day of April, 2007.

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